REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of September 11, 2008 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 50-0951.

Claim Rejections 35 USC § 101

Claims 13-18 were rejected under 35 U.S.C. § 101 because it was alleged that the claimed invention is directed to non-statutory subject matter.

Although Applicants disagree with the rejection, Claims 13-18 have been cancelled to facilitate prosecution of the instant application.

Claim Rejections 35 USC § 103

Claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application 2003/0212800 to Jones, et al. (hereinafter Jones), in view of U.S. Published Patent Application 2003/0014668 to Faccin, et al. (hereinafter Faccin), and in further view of non-patent literature reference, "A Service Framework for Carrier Grade Multimedia Services Using Parlay APIs Over a SIP System" to Pailer (hereinafter Pailer).

Although Applicants respectfully disagree with the rejections, Applicants have amended Claim 1. Applicants have cancelled Claims 4-24. However, Applicants are not conceding that the remaining claims as originally formulated or the cancelled claims fail to present patentable subject matter. The amendments and cancellations are solely for the purpose of expediting prosecution. Accordingly, neither the amendments nor cancellations should be interpreted as the surrender of any subject matter, and Applicants

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expressly reserve the right to present the original version of any of the amended claims in any future divisional or continuation applications from the present application.

As discussed herein, the claim amendments are fully supported throughout the Specification. No new matter has been introduced by the claim amendments.

Aspects of Applicants' Invention

It may be helpful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. One embodiment of the invention, as typified by amended Claim 1, is a method of authenticating a mobile communication device within a mobile network (voice network) and a wireless network (data network).

The method can include providing a mobile communication device configured to communicate over the mobile network and the wireless network, the mobile communication device including a Session Initiation Protocol (SIP) user agent executing therein; the mobile communication device receiving authentication data from a mobile service provider over the mobile network when the mobile communication device is within communication range of the mobile network; the mobile communication device building a SIP referred by token using the authentication data received from the mobile service provider; the mobile communication device sending the token to a SIP server via a wireless communications link over the wireless network.

The method also can include the SIP server interpreting the token and forming a Parlay request for authentication using data specified by the token; the SIP server sending the request for authentication of the mobile communication device to the mobile service provider; the mobile service provider confirming or denying the request for authentication by sending a response to the SIP server; the SIP server receiving the response from the mobile service provider and sending a reply to the mobile communication device over the wireless communications link indicating whether the

request for authentication was confirmed; and the mobile communication device receiving the reply from the SIP server.

See, e.g., Specification, paragraphs [0018] to [0025]; see also Fig. 2.

The Claims Define Over The Prior Art

As discussed above, Claim 1 of the instant application has been amended to even more clearly define the present invention. Applicants submit that none of the cited references, alone or in combination, discloses the specific steps as recited in amended Claim 1.

Jones discloses a method for allowing multiple service providers to provide services via a common access network. The access network is arranged with multiple logical network layers, each specific to a respective service provider. Upon successful authentication of a subscriber by a given service provider, the access network assigns that subscriber to the logical layer specific to the authenticating service provider. The access network then handles communication traffic in that logic layer in a manner specific to the service provider. See the Abstract.

Cleary, Jones concerns allowing multiple service providers to provide services via a common access network, which has nothing to do with the subject matter of the present invention, namely authenticating a mobile communication device within a mobile network and a wireless network.

It was asserted in the first paragraph on page 3 of the Office Action that Jones teaches that a request is formed using data obtained over a mobile communications link of a mobile network (p.2, paragraph 22 of Jones). It is noted that in Jones the subscriber sends an authentication request message to the access network, which "might identify service provider system and might provide a user name and password." However, Jones does not discloses "the mobile communication device receiving authentication data from

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a mobile service provider over the mobile network when the mobile communication device is within communication range of the mobile network; the mobile communication device building a SIP referred by token using the authentication data received from the mobile service provider," as recited in Claim 1 of the instant application. It as also asserted in the Office Action that the above limitation as claimed constitutes non-functional descriptive material and is not given any weight for patentability purposes. Nonfunctional descriptive material normally includes music, literary works, and a compilation or mere arrangement of data. It is not clear how the claimed limitation, which describes a method step, constitutes non-functional descriptive material.

It was asserted in the second paragraph on page 3 of the Office Action that Applicant has failed to limit the definitions of the two types of networks (the mobile network and the wireless network) such that the distinction may be given weight for patentability purposes. Although Applicants believe that a person skilled in the art would understand the distinction between the two types of networks, a brief definition has been added to Claim 1 to facilitate prosecution of the instant application.

Faccin and Pailer do not make up for the deficiencies of Jones. Further, although Faccin and Pailer mention the use of SIP protocol, Faccin and Pailer do not disclose the specific steps as recited in Claim 1 of the instant application.

Accordingly, the cited references, alone or in combination, fail to disclose or suggest each and every element of Claim 1, as amended. Applicants therefore respectfully submit that amended Claim 1 defines over the prior art. Furthermore, as each of the remaining claims depends from Claim 1 while reciting additional features, Applicants further respectfully submit that the remaining claims likewise define over the prior art.

Applicants thus respectfully request that the claim rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,
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